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7590 02/26/2004			EXAMINER	
Gregory A. Nelson Akerman Senterfitt 222 Lakeview Avenue, Fourth Floor P.O. Box 3188 West Palm Beach, FL 33402-3188			ELAHEE, MD S	
			ART UNIT	PAPER NUMBER
			2645	5

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,391

Applicant(s)

CREAMER ET AL.

Examiner

Md S Elahee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed 12/13/03. Claims 1-25 are pending.

Response to Arguments

2. Applicant's arguments filed 12/13/03 have been fully considered but they are not persuasive.

Regarding claims 1, 7, 14 and 20, The Applicant argues on page 8, lines 7-9 that "In contrast to the teachings of Epler, the present invention does not utilize a Distinctive Ringing feature to provide varied call waiting tones". The examiner disagrees with this argument. Because, the applicant is silent about the definition of 'distinctive call waiting tone' in the specification. For example, it does not say whether the tone is a single pulse or a repeated pulse. Furthermore, the dictionary teaches that tones are pulses which can be repeated, therefore, Epler's ringing signals are equivalent to the claimed 'distinctive call waiting tone'. Thus the rejection of the claims in view of Epler remain.

Regarding claims 3, 12, 15 and 21, it is agreed that "Epler does not teach that the calling number can be evaluated to determine whether the area code of the calling number is the same as the area code of the called number" with respect to the applicant's argument on page 8, lines 14-16. Thus a new ground of rejection in view of Epler and Mizikovsky for claim 1 is applied below. Furthermore, it is also agreed that Epler fails to teach that the call information can specify information such as the time of day at the point of origin, a geographic location, and a time zone indication on page 8, lines 17-20 with respect to the applicant's argument. Thus a new ground of rejection in view of Epler, Kuechler and Neil for claims 12, 15 and 21 is applied below.

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Regarding claims 17 and 24, The Applicant further argues on page 8, lines 17-20 that Epler fails to teach "the subscriber configuring the various call characteristics that are compared to determine which call waiting tone is to be played". The examiner disagrees with this argument. Because, the applicant is silent about the feature in the claimed limitation of claims 17 and 24. Furthermore, from the claim limitation on page 5, lines 4, 5 and page 6, lines 5, 6 of claims 17 and 24, it is not clear whether the selection is made by caller or called party. However, Epler does teach that the caller is making selection (col. 6, lines 2-21). Thus the rejection of the claims in view of Epler remain.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore the examiner has given the claim language its broadest reasonable interpretation.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4-11, 13, 14, 16, 17, 19, 20 and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Epler et al. (U.S. Patent No. 6,026,156).

Regarding claim 1, Epler teaches establishing a telephone call with a caller (col.5, lines 60-67, col.6, lines 1-21; 'caller' reads on the claim 'calling party').

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Epler further teaches receiving from the caller a specified telephone number of the user in the existing telephone call (col.5, lines 60-67, col.6, lines 1-21; 'caller' reads on the claim 'calling party' and 'user' reads on the claim 'participant').

Epler further teaches causing a distinctive call waiting tone to be sent to the user wherein the distinctive call waiting tone is specified with the caller (col.5, lines 60-67, col.6, lines 1-21; 'caller' reads on the claim 'calling party' and 'user' reads on the claim 'participant').

Epler further teaches responsive to the user electing to speak with the caller, transferring the established call to the user (col.5, lines 60-67, col.6, lines 1-21, 28-67; 'caller' reads on the claim 'calling party' and 'user' reads on the claim 'participant').

Regarding claims 2 and 10, Epler teaches receiving from the caller call information, and sending a distinctive call waiting tone to the user based upon the call information (col.5, lines 60-67, col.6, lines 1-21, 28-67; 'caller' reads on the claim 'calling party' and 'user' reads on the claim 'participant').

Regarding claims 4 and 8, Epler teaches that the call information comprises VIP code, and further comprising the step of verifying the CPID (col.13, lines 65-67, col.14, lines 1-20; 'VIP code' reads on the claim 'password information').

Regarding claim 5, Epler teaches receiving CPID or VIP code to the Enhanced Call Waiting System, and verifying the call waiting CPID or VIP code when the call is received by the Enhanced Call Waiting System (col.13, lines 65-67, col.14, lines 1-20, 61-67, col.15, lines 1-4; 'CPID or VIP code' reads on the claim 'subscriptions' and 'Enhanced Call Waiting System' reads on the claim 'call waiting service provider').

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Regarding claim 6, Epler teaches providing a list to the caller of available VIP code, receiving from the caller a selection of a VIP code, and sending a distinctive call waiting tone to the user according to the selection (col.5, lines 60-67, col.6, lines 1-21, col.11, lines 33-53; 'VIP code' reads on the claim 'call waiting messages' and 'user' reads on the claim 'participant').

Regarding claim 7, Epler teaches an Enhanced Call Waiting System configured to receive a call from a caller to identify in the received call a telephone number associated with the user (col.5, lines 60-67, col.6, lines 1-21; 'Enhanced Call Waiting System' reads on the claim 'call waiting service provider', 'caller' reads on the claim 'calling party' and 'user' reads on the claim 'participant').

Epler further teaches a distinctive call waiting tone generator configured to generate distinctive call waiting tones based upon characteristics of the caller (col.5, lines 60-67, col.6, lines 1-21; 'caller' reads on the claim 'calling party').

Epler further teaches a switch for transferring the received call to the user if the user elects to accept the received call (col.5, lines 60-67, col.6, lines 1-21, 28-67; 'user' reads on the claim 'participant').

Regarding claim 9, Epler teaches providing a list of available VIP code, receiving from the caller a selection of a VIP code, and a programmed call processing system for receiving from the caller a selection of a message, and for assigning a call waiting tone according to the selection (fig.1, fig.3; col.5, lines 60-67, col.6, lines 1-21, col.8, lines 15-18, col.11, lines 33-53; 'list' reads on the claim 'table', 'VIP code' reads on the claim 'call waiting messages' and 'programmed call processing system' reads on the claim 'data processing system').

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Regarding claim 11, Epler teaches that the call information identifies the call as the category in which caller's calls fall with respect to the user and the system sends a distinctive call waiting tone to indicate to the user that the call is as the category in which caller's calls fall (col.14, lines 61-67, col.15, lines 1-4; 'the category in which caller's calls fall' reads on the claim 'out-of-area code' and 'user' reads on the claim 'participant').

Regarding claim 12, Epler teaches that the call information identifies comprises at least one selected from the group consisting of the category in which caller's calls fall (col.14, lines 61-67, col.15, lines 1-4; 'the category in which caller's calls fall' reads on the claim 'out-of-area code, password, time of day at point of origin, geographical location, and time zone information').

Regarding claim 13, Epler teaches that the system comprises a database comprising CPID or VIP code, and a programmed call processing system for comparing the telephone number received from the caller to the CPID or VIP code in the database (fig.1, fig.3; col.8, lines 15-18, col.13, lines 65-67, col.14, lines 1-20, 61-67, col.15, lines 1-4; 'CPID or VIP code' reads on the claim 'subscription information' and 'programmed call processing system' reads on the claim 'data processing system').

Regarding claim 14, Epler teaches fixed data storage for storing a list of call characteristics (col.5, lines 60-67, col.6, lines 1-21; 'Enhanced Call Waiting System' reads on the claim 'call waiting service provider', 'caller' reads on the claim 'calling party' and 'user' reads on the claim 'participant').

Epler further teaches that a computer for matching the VIP code with entries in the list (col.13, lines 65-67, col.14, lines 1-20; 'VIP code' reads on the claim 'call characteristics').

Epler further teaches that a computer for detecting VIP code in received calls (col.13, lines 65-67, col.14, lines 1-20; 'computer' reads on the claim 'call analyzer' and 'VIP code' reads on the claim 'characteristics').

Epler further teaches a call waiting tone generator for producing distinctive call waiting tones according to the entries in the list which match the detected (col.5, lines 60-67, col.6, lines 1-21, col.13, lines 65-67, col.14, lines 1-20; 'VIP code' reads on the claim 'call characteristics').

Epler further teaches a switch for sending the distinctive call waiting tones to the users (col.5, lines 60-67, col.6, lines 1-21, 28-67; 'switch' reads on the claim 'tone transmitter' and 'users' reads on the claim 'participants').

Regarding claims 16 and 23, Epler teaches selecting the call characteristics from a list of VIP code (col.13, lines 65-67, col.14, lines 1-20; 'list of VIP code' reads on the claim 'menu of available call characteristics').

Regarding claims 17 and 24, Epler teaches that selection is made through a telephone connection (fig.3; col.13, lines 65-67, col.14, lines 1-20).

Regarding claim 19, Epler teaches VIP code verification structure (col.13, lines 65-67, col.14, lines 1-20; 'VIP code' reads on the claim 'password').

Regarding claim 20, Epler teaches storing a list of call characteristics (col.5, lines 60-67, col.6, lines 1-21; 'Enhanced Call Waiting System' reads on the claim 'call waiting service provider', 'caller' reads on the claim 'calling party' and 'user' reads on the claim 'participant').

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Epler further teaches detecting VIP code in received calls (col.13, lines 65-67, col.14, lines 1-20; 'computer' reads on the claim 'call analyzer' and 'VIP code' reads on the claim 'characteristics').

Epler further teaches comparing the VIP code to the list of VIP code to determine if there is a match (col.13, lines 65-67, col.14, lines 1-20; 'VIP code' reads on the claim 'call characteristics').

Epler further teaches generating a call waiting tone according to the VIP code of the match (col.5, lines 60-67, col.6, lines 1-21, col.13, lines 65-67, col.14, lines 1-20; 'VIP code' reads on the claim 'call characteristics').

Epler further teaches sending the distinctive call waiting tones to the user (col.5, lines 60-67, col.6, lines 1-21, 28-67; 'user' reads on the claim 'participant').

Regarding claim 22, Epler teaches editing list of VIP code (col.11, lines 34-53; 'editing' reads on the claim 'creating' and 'VIP code' reads on the claim 'call characteristics').

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Epler et al. (U.S. Patent No. 6,026,156) and in view of Mizikovsky (U.S. Patent No. 5,559,860).

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Regarding claim 3, Epler fails to teach "said call information identifies said call as out-of-area code with respect to said participant". Mizikovsky teaches that the calling party identification data (i.e., call information) identifies the call as out-of-area code with respect to the participant (col.12, lines 61-67). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Epler to have the call information identifying the call as out-of-area code with respect to the participant as taught by Mizikovsky. The motivation for the modification is to have doing so in order to provide a distinctive ringing signal representative of a long distance caller.

7. Claims 12, 15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epler et al. (U.S. Patent No. 6,026,156) and in view of Kuechler et al. (U.S. Patent No. 6,108,630) and further in view of Neil (U.S. Patent No. 5,930,501).

Regarding claims 12, 15 and 21, Epler fails to teach "said call information comprises at least one selected form the group consisting of out-of-area code, time of day at point of origin, geographical location, and time zone information". Kuechler teaches that the call information comprises at least one selected form the group consisting of out-of-area code, time of day at point of origin (fig.4; col.6, lines 13-17). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Epler to have the call information comprising at least one selected form the group consisting of out-of-area code, time of day at point of origin as taught by Kuechler. The motivation for the modification is to have doing so in order to produce the audible flag.

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Epler in view of Kuechler fails to teach that the call information comprises at least one selected from the group consisting of geographical location, and time zone information. Neil teaches that the call information comprises at least one selected from the group consisting of geographical location, and time zone information (col.13, lines 31-39). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Epler in view of Kuechler to have the call information comprising at least one selected from the group consisting of geographical location, and time zone information as taught by Neil. The motivation for the modification is to have doing so in order to take advantage of commercially available telephone caller identification device.

8. Claims 18 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epler et al. (U.S. Patent No. 6,026,156) and in view of Baals et al. (U.S. Pub. No. 2002/0146107).

Regarding claims 18 and 25, Epler fails to teach "selection is made through an Internet connection". Baals teaches selection is made through an Internet connection (fig.4A; page 1, paragraph 0009, page 2, paragraph 0027). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Epler to have the selection is made through an Internet connection as taught by Baals. The motivation for the modification is to have doing so in order to provide selection using web based IP switching.

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Swan et al. (U.S. Patent 6,263,071) teach Telecommunications functions management system providing distinctive alerting based on caller selected option.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alam Elahee whose telephone number is (703) 305-4822. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

M. E.

MD SHAFIUL ALAM ELAHEE
February 18, 2004

Allan Hoosain
ALLAN HOOSAIN
PRIMARY EXAMINER
for
Fan Tsang